Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1, 3-4, and 6-34 are pending in the application, with claims 1, 27, 28, 29, 30 and 31 being the independent claims. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Description of the Invention

The present invention is directed to a method and system for providing rich media content over a computer network and more particularly to a highly reliable, transparent process for displaying high-quality online advertising imagery. As described in the invention, in the online advertising context, the process for providing rich media content, such as video advertisements, must be "entirely passive and nearly instantaneous" to be most effective. Attempts to put video advertising onto Internet web pages have largely failed because of two fundamental technical characteristics of computer video—lack of standardization and very large file size—and their implications. Computer users are generally unwilling either to wait for large files to be transmitted or to take active steps to ensure a smooth replay, especially for the sake of viewing an

advertisement. Advertisers are unwilling to spend money and effort on technologies that cannot reliably deliver uninterrupted imagery to a wide audience.

The present invention, on the other hand, provides a method for reliably delivering video ads without any interruption of the user's viewing experience. The present invention provides a highly reliable, entirely transparent process for displaying high-quality rich media content over a computer network. In accordance with one embodiment of the present invention, a server on a computer network automatically and transparently polls the software, hardware, or electronic appliance of an end user on the network, for the availability of software and/or hardware necessary for the local display of rich media content. Based on the client's response, the server automatically and transparently sends an appropriately formatted version of the rich media file to the client. Once the rich media file has been transferred in its entirety and stored, or cached, in the local memory of the client, the rich media content is displayed automatically, either immediately or according to a predefined schedule or display cue, in a designated display area. The user may then be able to manipulate the rich media content without affecting the other content or tasks that were being displayed prior to the display of the rich media content. The entire process of the present invention is transparent to the end user and requires no initiation or other action on the part of the end user. The process of the present invention takes place in the background, while the user is performing other tasks or viewing other content than that which is being transferred.

Rejections under 35 U.S.C. § 103

Claims 1, 3-4, and 6-30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,314,451 to Landsman *et al.* ("the Landsman patent"). The Examiner argues that the Landsman patent appears to disclose "a system and method for providing rich media contents to a user over a network comprising: a) determining media files and/or programs required to playback the media content delivered to user without a user request, i.e., advertisements, (b) transparently downloading into a local cache a version of the media content appropriate for the user to playback the content locally including a rich media file and an appropriate media player, [and] c) displaying/playing the media content, i.e. ads, to the user in a designated display area after the media content has been completely downloaded" (2/17/04 Reply at 2) (citations omitted). The Examiner argues that while the Landsman patent "does not explicitly teach the step of determining whether a particular program component has been resident in the user's computer, i.e., providing ability to playback the media content," it would have been obvious to one of ordinary skill in the art "to recognize such determination step in Landsman because it would have enabled the system to reduce downloading unnecessary program components for the media content" (*Id.* at 2-3) (citation omitted). Applicants traverse this rejection.

The Landsman patent teaches a technique that "persistently instantiates an agent" on the client (Landsman patent, both at Abstract and at col. 10, line 3). "Once loaded and started, the agent executes in parallel, with standard browser functionality, continually and transparently requesting and downloading advertisements" (*Id.* at col. 10,

lines 27-29). The agent also executes other functions; for example, it "monitors a click-stream generated by a user" (*Id.* at col. 10, lines 38-39), and it creates a "log" of "client-side information" and "uploads the log entries to the advertising server" (*Id.* at col. 13, lines 37-51).

Applicants' invention, on the other hand, neither creates nor uses any such persistent executable code on the client. Instead, it explicitly locates its persistent activity on the *server*, not on the client. For example, Applicants' Summary of the Invention states, "a server on a computer network polls the software, hardware, or electronic appliance of an end user on the network" (page 9, lines 5-6), and "the server sends an appropriately formatted version of the rich media file to the client" (lines 9-10). Descriptions in the Detailed Description of the Preferred Embodiments also explicitly locate the activity on the server; for example, the first activity following the establishment of a connection is, "as shown in Figs. 1B and 3, server 103 sends a query to client 102. Query 108 is a communication wherein server 103 requests data from client 102 regarding the presence or absence of specific software and/or hardware that are required to display rich media file 105" (page 12, lines 7-10).

The exception noted by the Examiner and cited above illustrates this distinction. The technique taught by the Landsman patent does not explicitly teach determining whether a particular program component has been resident in the user's computer, instead mentioning only parenthetically that the persistent agent resident on the client downloads player files "where necessary" (col. 10, line 6). In contrast, Applicants'

invention, as claimed, requires a determining step, since it locates persistent activity on the server.

This distinction is neither arbitrary nor trivial. A process intended to affect a device on a network cannot be placed arbitrarily on any device in the network; either it must be installed on the device it is intended to affect, or there must be secondary processes active on both the installation device and the affected device that permit the primary process to function. Installation directly on the affected device is the approach taught in the Landsman patent (as discussed above), and also in the five other patents cited in the Notice of References Cited included with the February 17, 2004 Office Action. It is by far the easier approach, but it raises issues of compatibility with client operating systems and – increasingly importantly – with privacy and security. (Applicants' Background of the Invention mentions this distinction from the persistent agent central to the Landsman patent; see page 8, lines 12-17.) The latter approach, i.e., working indirectly via compatible secondary processes already installed and active on both the server and the client, is adopted by the present invention. It is much more difficult, in part because it is not obvious that any such compatible secondary processes will even exist for a given primary process, much less that execution of the primary process can be reliable and transparent.

To clarify this distinction, independent claims 1, 27, 28, 29 and 30 are amended to recite that the determining step proceeds "without downloading executable code that persists on the user's storage media." This is explicitly distinct from the approach described in the Landsman patent. For at least this reason, independent claim 1, and

claims 3-4, and 6-26, which depend therefrom, are patentable, and Applicants respectfully request that the Examiner reconsider the outstanding rejection and that it be withdrawn. Similarly, for at least this reason, independent claims 27, 28, 29, and 30 are also patentable, and Applicants respectfully request that the Examiner reconsider their rejection and that it be withdrawn.

Claims 31-34 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,951,639 to MacInnis ("the MacInnis patent"). The Examiner argues that the MacInnis patent appears to disclose "a method for playing rich media content provided over the network comprising: a) determining user's ability to play the media content, i.e., by referencing system configuration table, b) comparing user's ability against a schedule of media file versions/formats available on the network, c) selecting a version of the media content that is best matched with the user's ability, [and] d) downloading the entire selected media file into a local storage for playing the media content" (2/17/04 Reply at 4) (citations omitted). Applicants traverse this rejection.

The MacInnis patent teaches a system and method designed specifically to operate "without requiring two-way client-server communication" (col. 2, lines 12-13, and similarly at lines 21-22). No queries of a server or responses from a client are possible. Lacking information about, or communication with, any client, the server "broadcasts" all versions of the available data to all clients (see col. 2, lines 39-43).

In contrast, Applicants' invention explicitly involves one or more instances of polling by a server, followed by a client's response. Only a particular version of a file is sent to a client, based on that client's reply to a query.

Implementation of Applicants' method would be impossible in the environment described explicitly in the MacInnis patent, and any process involving communication from client to server as required by Applicants' method would destroy the teaching of the method described in the MacInnis patent.

Like the Landsman patent, the MacInnis patent requires a persistent program located at the client that executes the method. The functions of this program are described throughout both the Summary of the Invention (e.g., col. 2, lines 36-38 and 43-49) and the Detailed Description (e.g., col. 4, lines 28-34; col. 6, lines 51-64), and the Figures (e.g., Figs. 4 and 5). According to the MacInnis patent, "descriptors" are downloaded to a plurality of terminals and compared locally to an internal configuration table to select the "best" module version for that terminal. Implementation of the method disclosed in the MacInnis patent would clearly be impossible without a persistent executable program on the client side.

In contrast, as noted above, Applicants' invention uses no such persistent executable code on the client. Instead, it explicitly locates its persistent activity on the server, not on the client. This would be impossible in the environment of the MacInnis patent without destroying its teaching on communication limitations.

To clarify this distinction, independent claim 31 is amended to recite that the determining step proceeds "without requiring executable code that persists on the user's storage media." This distinguishes the present invention explicitly from the MacInnis patent. For at least this reason, independent claim 31, and claims 32-34, which depend

therefrom, are patentable, and Applicants respectfully request that the Examiner reconsider the outstanding rejection and that it be withdrawn.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all currently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

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